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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Oliver SCHADT et al.

Examiner: GRAZIER, Nyeemah

Serial No.: 10/511,155

Group Art Unit: 1626

Filed: October 14, 2004

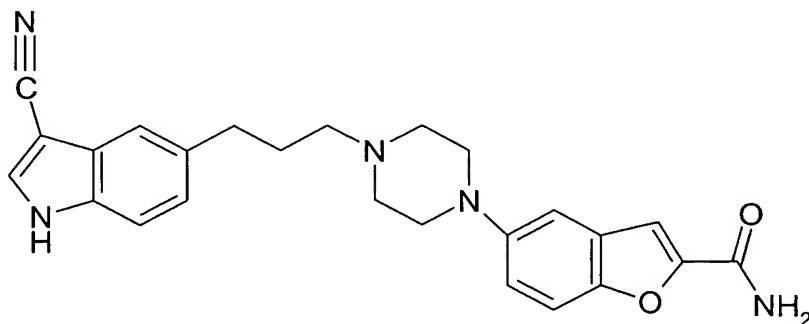
Title: SUBSTITUTED INDOLES

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated January 25, 2006, Applicants hereby elect Group VIII, with the caveat that Z has benzofuran includes substituted benzofurans. To the extent that, in addition to the above election, page 9 of the Office Action requires the selection of a single species, Applicants hereby elect the following compound:



The requirement for restriction is respectfully traversed.

The requirement for restriction is respectfully traversed, inasmuch as it is earnestly submitted that the entirety of the present claims possess unity of invention under 37 C.F.R. §1.499. As noted

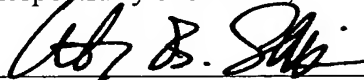
at page 3 of the Office Action, annex B of the administrative instructions under the PCT (unity of invention) states that, for "Markush Practice" where a single claim defines alternatives, the requirement of a special technical feature "shall be considered to be met" when the alternatives are of a "similar nature." The instructions state that when the Markush grouping "is for alternatives of a chemical compound, they *shall* be regarded as being of a similar nature (emphasis added), where the following criteria are fulfilled:

- (A) All alternatives have a common property or activity, and
- (B) (1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives, or
- (B) (2) In cases where the common structure cannot be unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

In the present situation, as noted at page 3 of the Office Action, the common structural feature of the claimed compounds is an indole ring having a side chain. It is important to note that, for the Markush Practice situation, the administrative instructions do *not* require that patentability be based on the "special technical feature." The rules require only "common structure" or belonging to a "recognized class" of compounds. The only mention of novelty is the notation that, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention "shall be reconsidered." The instructions then state that reconsideration does not necessarily imply that an objection of lack of unity shall be raised. It is thus evident that patentability over the art is *not* required in the Markush situation to establish unity of invention. Rather, the special technical feature need only possess common structure and a common property or activity. Common structure is evident, as noted in the Office Action, from the claims. Common properties are evident in that, as stated in the specification, the compounds have action on the central nervous system. Accordingly, it is submitted that the requirement for a special technical feature is satisfied, that unity of invention is clearly present in the present compounds, and that the requirement for restriction should be withdrawn. The same is respectfully requested.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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